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Willcox, (2 Atk. 142) and see *Lofft*, 775. I confess I do not understand why an abridgment tending to injure the reputation, and to lessen the profits of an author, should not be considered an invasion of his property." When an actual case presenting the precise point is presented for judicial determination and expressly decided, it will be time enough to regard the question as settled by authority.

Till then, however, it must still be regarded as open for discussion.

In the Circuit Court of the United States for the Hartford District.

THE AMERICAN PIN COMPANY vs. THE OAKVILLE COMPANY ET AL.

1. The extent of the rights secured to the patentee stated, and the case of *O'Reilly vs. Morse* cited and affirmed.
2. The means specified in the patent to produce the effect, and nothing more, are secured to the patentee, and there can be no infringement unless the same substantial means are used in both the plaintiffs' and defendants' machines.

The facts of this case fully appear in the opinion of the Court, which was delivered by

INGERSOLL, J.—The complainants, by their bill seek to enjoin the defendants from using a machine to paper pins, the right to use which, they claim to be exclusively vested in them. The foundation of their claim rests upon two certain patents, the right to which Patents, with the privileges by such patents granted, they now have by virtue of assignments from the patentees. One of these patents, was issued to Samuel Slocum, and bears date the 30th day of September, A. D. 1841, and was to run for fourteen years from the last mentioned date. The other Patent was issued to John J. Howe, and bears date the 24th of February, A. D. 1843, and was to run fourteen years from the 5th day of December, A. D. 1852. The validity of these patents is not contested by the defendants. They admit that the complainants have all the rights which these Patents purport to grant. They admit further, that they are using a machine for papering pins; but they deny, that by such use, they have infringed upon any of the rights so granted by such patents.

The defendants claim a right to use the machine for the papering of pins, which they are operating, upon the ground that by such use, they do not infringe upon any rights granted by such patents, or either of them. They claim also that the right to use such machine, so operated by them is exclusively vested in them by virtue of a patent granted to Chauncey O. Crosby, and which last mentioned patent, they have by virtue of an assignment from the patentee.

There has been heretofore, at times, some diversity of opinion, as to the extent of the rights, secured to an inventor or discoverer, by the patent issued in his favor. The Supreme Court of the United States have however, settled and determined, what rights are so secured to the patentee; so that now, there can be no diversity of opinion on the subject. In the case of *O'Reilly et al. vs. Morse, et al.* 15 Howard's Reports, page 62, the rule as laid down by the Chief Justice, in giving the opinion of the Court, is in substance as follows :

He who discovers that a certain useful result will be produced in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for such discovery, provided he sets forth in his specification, the means he uses to produce such useful result, in a manner so full and exact, that any one skilled in the art or business to which it appertains can by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done, by the means he describes, the patent is void. And if it can be done then the patent confers on him the exclusive right, to use the means he specifies, to produce the result or effect he describes, and nothing more. And it makes no difference in this respect, whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy known or unknown, before his invention; or by machinery acting together upon mechanical principles. In either case he must describe the manner and process as above mentioned, and the end it accomplishes. And every one may lawfully accomplish the same end, and without infringing the patent, if he uses means substantially different from those described. But if the means used to accomplish the

same end, are substantially like those which the patentee describes, the patent has been infringed, and the one using them must be responsible for such infringement.

The rules thus laid down must govern this case. The patent does not secure to the patentee the result or effect produced, but only the means described, by which such result or effect is produced.

The means which he specifies, to produce the result or effect, are secured, and nothing more. And all other means to produce the same result or effect and not patented to any one, are open to the public. A mere change in the form of the machinery, however, or the means specified, by which the result or effect described is produced; or an alteration in some of the unessential parts, or a substitution or use of known equivalent mechanical powers, not varying essentially the machine, or its mode of operation or organization, will not make the new machine a new invention. The patentee may however limit his claim, in his specification, to one particular form of machine, and thus exclude all other forms, though such other forms, would embody his invention, and thereby not secure to himself, the whole that he has invented. In such a case, he is secured only in the particular form claimed. The patent law was intended to secure to the inventor, his whole invention or discovery, but not unless he claimed to be secured, in the whole. And if he claims only a part, or some particular form, such part, or particular form only is secured to him. No more can be secured by the patent, than has been invented or discovered; and no more can be secured, than is claimed to be secured in the specification.

In the case of *Winans vs. Denmead*, 15 Howard, 330 the substantial means used by the defendant to accomplish the object sought, were the same as those described and claimed in the specifications to the plaintiffs' patent. There was no other change, than a slight change of form not varying in substance the means used by the plaintiff and set forth and described in the specification to his patent. And as a mere change in the form of the machinery, or the means specified, by which the result is produced, not varying essentially the mode of operation of the thing patented, will not vary its organization, or be deemed a new or different invention, the de-

fendant was deemed to have been an infringer of the plaintiffs' rights secured to him by his patent.

The invention of Slocum as described in his specification, is a "machine for sticking pins into paper" in a row. It consists of a horizontal plate as described, with as many grooves, as the number of pins, intended to be stuck in a row; which grooves are of sufficient length and depth to receive one pin and one only; a sliding hopper so constructed as to hold a number of pins, one directly over the other in a horizontal position, and so made to slide directly over the grooves, as to deposit one of the pins in each groove by gravitation; and a sliding plate or follower, upon the front edge of which project a system of points or wires corresponding with the grooves, so that when the sliding plate or follower is driven forward, the wires enter the grooves, in which the pins are separated, and drive forward the pins, which are thus made to perforate the previously adjusted folds of a folded and crimped paper, which is held between clamps. And in the specification Slocum claims as his invention, the plate with grooves, as described, for separating the pins, the sliding hopper, which deposits the pins in the grooves as described; and the sliding plate or follower, with the wires attached thereto, in combination with the groove plate as described, and also these in combination with the hopper as described. The invention of Howe, as described in his specification, is for an improvement on Slocum's machine for sheeting pins, that is, for sticking pins in rows in sheets of paper. The machine of Slocum did not crimp the paper. But the paper was crimped in the old way by a separate operation, and then taken out of the crimping apparatus, and placed in clamps, and while in such clamps, and out of the crimping jaws, the pins perforated through the crimps previously formed, and in that way were sheeted. The improvement of Howe upon the machine of Slocum, crimped the paper, and the pins were stuck in rows in the paper, while the paper was within and held by the crimping apparatus.

This improvement consisted of transverse notches made in the crimping jaws of the old crimping apparatus, so that the pins could enter at proper distances between the crimping jaws, and perforate the paper, while the same was being crimped. Before this improve-

ment, no method was known by which the pins could be made to penetrate the paper, and thus be sheeted, while the paper was under the process of being crimped. The old mode was to stick the pins after the paper had been crimped. Howe's improvement was by means of these transverse notches, to stick the pins, while the paper was in the crimping process, when it was being crimped, and while the crimper, which crimped the paper, held the paper in the form that it was crimped. It was not to sheet the pins, after the paper had gone through the crimping process, and had passed out of the crimping jaws. He in substance took the old English crimping bar, and made transverse notches in it, at suitable distances between the jaws, so that the pins could penetrate through these notches, into and through the crimps of the paper when the paper was within the crimping jaws, and in the process of being crimped.

The patent which was granted to Crosby, bears date the first day of April, A. D. 1851. The machine which the defendants are operating, is constructed substantially according to the specifications annexed to that patent. Crosby in his specification claims to be the inventor of "a new and useful machine for sticking pins," and the patent is granted to him according to his claim for "a new and useful machine for sticking pins on paper." The specification and claim are not for an improvement on Slocum's machine, or on Howe's machine for sticking pins; but for an independent machine, governed by different principles; for a machine to produce a result, by means substantially different from the means secured to either Slocum or Howe, to produce a like result, to wit, the "sticking of pins on paper." The patent is *prima facie* evidence, that Crosby has an exclusive right to that which the patent purports to grant; that he is the first inventor of the machine specified and described in his specifications; that he is the first inventor of an independent machine, governed by different principles, and using means, substantially different from the means used by either Slocum or Howe, to produce the like result. *Corning et al. vs. Burden*, 15 Howard, 252. The patent therefore to Crosby affords *prima facie* evidence, that the means described by him in his specifications, to produce the result of sticking pins on paper, are substantially different from the means described either by Slocum or Howe to produce the like result.

And the complainants, to succeed in their application, must counteract this *prima facie* evidence, by sufficient countervailing testimony.

The object of Crosby's machine, is to stick pins in a fillet of paper across the strip of paper, the crimps being length-wise of the paper; to crimp the paper in that way, and coil the fillet, when stuck, into a roll of any convenient size; so that the heads of the pins will be presented on the disk of the roll, and all by one continued operation. The essential parts of the machine, as operated by the defendants, or the substantial means by which the desired result of sticking the pins on paper is produced, are crimping rollers, by which the paper is crimped; an inclined channel way formed by two bars, by which the pins are made to slide down in a verticle position, hanging by their heads, between the two bars; a revolving screw, one end of which is placed at the bottom of the channel way, and by revolving, at each revolution is made to take in its thread, from the bottom of this channel way, one pin at each revolution, from the body of pins in the channel way, and separate the same from the body of pins, and carry it by the mechanical force of the revolution of the separating screw, to the other end of the screw, to change the pin from a vertical to a horizontal position, and at the end of the screw to which the pin is carried, to cause it to drop, in a horizontal position into a groove-channel; and a punch at the head of the pin, as it is dropped into the groove-channel, which by machinery is made to drive the pins forward at regular intervals, as fast as they drop into the groove-channel, into the crimped paper, after it has passed out of the jaws of the crimping rollers. When the paper is stuck, it has, in the place where stuck, passed out of the crimping jaws: and during this operation, one end of the paper is held in a rigid state by the crimping rollers, and the other end by the coiling roller. The paper is stuck on its passage from the crimping rollers to the coiling roller; and as the paper is stuck, it is coiled into a roll. The machine is automatic, while other machines known before, are not so.

The object of Slocum was to paper the pins at given specified distances apart. And for that purpose, he used a plate, with a cer-

tain number of grooves in it, into which the pins were placed by certain machinery, and through which grooves the pins were pushed into the paper. The distances apart, at which the pins were pushed into the paper were regulated and controlled by the distances of the grooves in the plate, and by these distances only. And his machine was so organized as to regulate the distances at which the pins should be separated and stuck into the paper by the distances apart of the grooves in the plate. This was a mechanical law of his machine. There is no such mechanical law of the defendants' machine.

As in the machine of Crosby there is only one groove, through which the pins are pushed, one at a time, into the paper, the distances apart at which they are pushed into the paper by his machine, cannot be regulated by any such mechanical law. These distances therefore are dependent upon some other mechanical rule; upon some other mechanical organization. In Slocum's machine, these distances are regulated by one organization. In Crosby's machine they are regulated by another and different organization. In Slocum's machine, the distances apart of the grooves in the plate, control the manner in which the pins are placed in the paper. In Crosby's machine, an entirely different organization of the machine controls the manner in which the pins are placed in the paper.

Before the invention of Slocum, grooves or channels had been used, in which to place the pins, with the view to push them into paper, and they had been pushed in, in various ways. The grooves used by him as the channel to push the pins into the paper, were also used to separate the pins; as a channel to deposite the pins one by one in each groove, as they dropped from the hopper, when the hopper passes over the plate. Previous to his invention, the separation had been made by hand, and he invented a particular mode of separation, other than by hand, and set forth in his specification the particular means he used to produce the result. The plate with grooves as he described it, for separating the pins, he claimed for his invention. He also claimed the sliding hopper, which passed over the plate, and deposited a pin in each groove, as his invention. He also claimed the sliding plate or follower with the series of wires attached thereto, as described by him, in com-

bination with his groove-plate as described; and these also in combination with the sliding hopper as described. This is all he did claim. Grooves, as such merely, through which the pins were pushed into the paper he did not claim. The object of his machine was, to separate the pins, from a pile or mass of pins, and place them in channels at suitable distances apart, to be pushed into the paper, and then by means of the plate, with the series of wires attached as described, to push them into the paper.

The instrumentalities or substantial means, in Slocum's machine, by which the pins are separated from a pile or column, preparatory to being pushed in the paper, are a hopper, and a bed containing grooves of the exact size of the barrel of the pin. And to effect this separation, the hopper must either slide over the plate with grooves, or the grooved plate must slide or otherwise pass under the hopper. And to enable the pin to be separated, it must be in the hopper in a horizontal position, or nearly so.—The separation cannot be accomplished by that machine, unless the hopper slides over the plate, or the plate slides, or in some other way passes under the hopper. Without one of these operations, the machine, for this purpose is useless. One of these operations is essential to it. It is not a Slocum machine, for separating, without one of these operations.

Neither of these operations can be found, either in form or in substance, in the Crosby machine.—There is no hopper in Crosby's machine, unless the inclined channel-way, in which the pins hang by their heads, in a vertical position, be considered as a hopper. That if it be considered as a hopper, does not move. It is stationary. Of course, it neither slides nor passes over anything. From the lower extremity of the inclined channel-way, the pins are taken one by one, by the thread of a screw, while revolving, and while the pin is vertical, and by force of mechanical power, the pin is carried in the thread of the screw, to the other end of the screw, and there deposited by the screw, in a horizontal position in a groove-channel. The screw while operating, has no motion, but a revolving motion. During the whole time, it remains in the same space. It neither moves forward nor back. There is then nothing

in the machine which, either in form or in substance, has any resemblance or similitude to the sliding hopper, sliding or passing over the recesses of the plate to receive the pins, as they drop from the hopper, or recesses for receiving pins, sliding or passing under a hopper. While in Slocum's machine, one of these processes must take place. And without one of them, a machine for this purpose cannot be a Slocum machine.

In the Slocum machine the recess of the plate, which receives the pins separately from the hopper, must be of the exact size of the barrel of the pin. In the Crosby machine, the recesses in the thread of the screw, which receive the pins, and by which they are transported to the other end of the screw, and which it is claimed, are a mechanical equivalent for the recess in the plate, with grooves in Slocum's machine, need not be of the exact depth or breadth of the barrel of the pin. They may be of any size, provided they are not sufficiently large to enable the head of the pin to fall through. The essential means therefore used in Crosby's machine, to bring about the result, to wit, a separation of the pins from the pile or column, are substantially different from the means used in Slocum's machine, to produce the same result. In this respect the two machines operate differently, and depend upon distinct organizations. The same substantial means are not used in each.

The mode in which the pins are pushed into the paper by the defendants' machine, is by a punch applied to the head of the pins, after they are deposited by the screw in the grooved-channel, by which the pins are made, one by one to penetrate the paper, in and through the crimps. Slocum does not claim as his invention or discovery, the mode generally of pushing pins through a grooved-channel into paper, by means of a punch applied to the head of the pin. The state of the arts, as shown to exist prior to the time of his invention, shows that he could not with success have made any such claim. His claim is for his plate, with a series of wires attached in combination with the grooved plate, as described by him, by which combination, a row of pins is stuck by one operation. The mode therefore, adopted by the defendants in their machine, is not embraced in Slocum's claim. They have a

right therefore to use it, notwithstanding the patent granted to him. From the description already given of the Howe machine, and of the Crosby machines as exhibited on the trial, it appears manifest, that the mode of operation of one, as it respects the improvement or invention as claimed by Howe, is different from the mode of operation of the other. Howe's invention was but an alteration of the old English crimping bar, by the cutting of transverse notches through the bar, where the two jaws meet; to enable the pins to pass through these notches, and thereby stick the paper, while it was within the crimping jaws, and while it was being crimped. The notches or apertures of some kind were an essential means to effect the result, which Howe designed by his invention. Without them, his improvement did not exist. There are no notches or apertures, in Crosby's crimping rollers, and nothing which bears any resemblance or similitude to them. The pins are stuck, not when the paper is within the crimping jaws, but after it had passed out of them. The device of Crosby is essentially different from that of Howe. The pins are stuck by Howe's invention while the paper is within the crimping jaws, by means of notches or apertures in the crimping bars. No such means are used by Crosby. The principles of the two machines, in their modes of operation, and in the means used by each to effect the result accomplished are different. They are not therefore identical. One is not an infringement upon the other.

With this view of the case, the decree must be that the complainants' bill be dismissed with costs to the defendants.

In the above opinion Judge Nelson fully concurs.

New York Superior Court—Special Term, November, 1854.

MORRIS KETCHUM ET AL vs. THE BANK OF COMMERCE OF NEW YORK.

1. Where stock sold by an avowed owner, dealing as owner, turns out afterwards to be spurious and void, by reason of its having been illegally issued, the purchaser may recover back the price paid, though the seller was ignorant of his want of title.